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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,139	09/10/2003	Jing-Hsiang Hsu	JCLA9793	6888
7590	08/18/2004			
J.C. Patents SUITE 250 4 VENTURE IRVINE, CA 92618				
			EXAMINER LUM, LEON YUN BON	
			ART UNIT 1641	PAPER NUMBER

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/660,139

**Applicant(s)**

HSU ET AL.

**Examiner**

Leon Y Lum

**Art Unit**

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a fabrication method for a biochip, classified in class 436, subclass 518.
  - II. Claims 6-7, drawn to an application of the biochip, classified in class 436, subclass 56.
  - III. Claims 8-12, drawn to a fabrication method for a biochip, classified in class 436, subclass 524.
  - IV. Claims 13-16, drawn to an application of the biochip, classified in class 436, subclass 800.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are unrelated, distinct, and independent. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Group I is a method that includes the step of performing a solid-phase peptide synthesis step to synthesize a peptide with a specific amino acid

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sequence on the aminated surface of a micro-carrier, which is a step missing from Group II. Group II is a method that includes the step of using an identification system to identify the dyed micro-carrier and reading the identification code on the micro-carrier to analyze the test-pending material that corresponds to the peptide with the specific amino acid sequence, which is a step that is missing from Group I.

Therefore, Groups I and II have different modes of operation that distinguish them as unrelated, distinct, and independent inventions.

4. Inventions I and III are unrelated, distinct, and independent. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Group I is a method that includes the step of performing a solid-phase peptide synthesis step to synthesize a peptide with a specific amino acid sequence on the aminated surface of a micro-carrier, which is a step missing from Group III. Group III is a method that includes the step of immobilizing an antibody (or antigen) on the aminated surface of a micro-carrier, which is a step that is missing from Group I.

Therefore, Groups I and III have different modes of operation that distinguish them as unrelated, distinct, and independent inventions.

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5. Inventions I and IV are unrelated, distinct, and independent. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Group I is a method that includes the step of performing a solid-phase peptide synthesis step to synthesize a peptide with a specific amino acid sequence on the aminated surface of a micro-carrier, which is a step missing from Group IV. Group IV is a method that includes the step of using an identification system to identify the dyed microchip and reading the identification code on the microchip to analyze the test-pending material that corresponds to the antibody (or antigen), which is a step that is missing from Group I.

Therefore, Groups I and IV have different modes of operation that distinguish them as unrelated, distinct, and independent inventions.

6. Inventions II and III are unrelated, distinct, and independent. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Group II is a method that includes the step of attaching a peptide of the specific amino acid sequence to the test-pending material to form a dyed microchip when there is an interaction between the test-pending material and the peptide with the specific amino acid sequence, which is a step missing from Group III.

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Group III is a method that includes the step of immobilizing an antibody (or antigen) on the aminated surface of a micro-carrier, which is a step that is missing from Group II.

Therefore, Groups II and III have different modes of operation that distinguish them as unrelated, distinct, and independent inventions.

7. Inventions II and IV are unrelated, distinct, and independent. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Group II is a method that includes the step of attaching a peptide of the specific amino acid sequence to the test-pending material to form a dyed microchip when there is an interaction between the test-pending material and the peptide with the specific amino acid sequence, which is a step missing from Group IV. Group IV is a method that includes the step of bonding a test-pending material to the antibody (or antigen) to form a dyed microchip when there is an interaction between the test-pending material and the antibody (or antigen), which is a step that is missing from Group II.

Therefore, Groups II and IV have different modes of operation that distinguish them as unrelated, distinct, and independent inventions.

8. Inventions III and IV are unrelated, distinct, and independent. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and

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they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Group III is a method that includes the step of performing a surface modification procedure to modify a property of a surface of the micro-carrier to an aminated surface, which is a step that is missing from Group II, which is a step missing from Group IV. Group IV is a method that includes the step of using an identification system to identify the dyed microchip and reading the identification code on the microchip to analyze the test-pending material that corresponds to the antibody (or antigen), which is a step that is missing from Group III.

Therefore, Groups III and IV have different modes of operation that distinguish them as unrelated, distinct, and independent inventions.

9. Because these inventions are distinct for the reasons given above and the search required for each of Groups I-IV is not required for the other Groups, restriction for examination purposes as indicated is proper.

10. A telephone call was made to Jiawei Huang on 9 August 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

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11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leon Y Lum whose telephone number is (571) 272-2878. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LYL



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8/15/07